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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,930	09/19/2001	Tsuyoshi Hiramatsu	3273-0146P	3012
2292	7590	10/13/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH			CHANG, VICTOR S	
PO BOX 747			ART UNIT	
FALLS CHURCH, VA 22040-0747			PAPER NUMBER	

1771

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/936,930

Applicant(s)

HIRAMATSU ET AL.

Examiner

Victor S. Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2006 and 08 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2,3,8 and 22-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,3,8 and 22-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Introduction***

1. Applicants' amendments and remarks filed on 8/8/2006 and 9/8/2006 have been entered.

Claim 2 has been amended. Claims 2, 3, 8 and 22-28 are active.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims, 8 and 22-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

More particularly, in the remarks filed 9/8/2006, page 2, applicants point to various Examples as the support of the new limitation of "a forming technique excluding a foaming technique". However, throughout the Examples, the adhesive layer is merely applied to a substrate and dried, nowhere is the aforementioned forming technique to be found. Since inherently "excluding a foaming technique" is equivalent to "free of a foaming technique", it is

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deemed to be new matter under the rule of *Ex Parte Grasselli et al.* – Bd. of App. 231 PQ 393, Affd. 738 F. 2d 453 (Fed. Cir. 1984). Further, in the remarks filed 8/8/2006, page 8, applicants argue that the aforementioned limitation is supported at page 48, lines 7-11 of the present specification. However, to the contrary the disclosure at page 48 merely teaches that extrusion foaming and injection foaming can be used to form a foam layer. Express or inherent support is requested in the next reply.

### ***Rejections Based on Prior Art***

5. Claims 2, 3, 8 and 22-28 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 11-254656 [machine translation].

JP 11-254656 relates to an adhesive sheet for screen printing plate cleaning. In a drawing, JP '656 shows that the adhesive sheet comprises a base (substrate) layer 2 and a self-adhesive foam layer 3. The adhesive sheet is pasted to the screen printing plate to adhere and absorb the ink, so as to remove (clean) the ink from the printing plate [abstract]. Suitable adhesives include natural rubber, styrene butadiene rubber, polyisobutylene, styrene-isoprene-styrene block copolymer, acrylic resin (such as a copolymer of acrylic acid and C<sub>2</sub>-C<sub>10</sub> alkyl ester), styrene-acrylic ester copolymer, etc. [paragraph 0008]. The expansion ratio varies widely between 1.2 to 100 times, i.e., ranges from substantially solid to highly expanded foam [paragraph 0009]. Further, JP '656 teaches that the tackiness of the adhesive layer is 1-200 gf/25-mm, measured by the test method JIS-Z-0237, and can be adjusted by choosing suitably a class of resin, a class of additive, an amount, etc. [paragraph 0011].

For claims 2 and 3, JP '656 is silent about the solvent absorption rate from the ink and the composition of the ink solvent. However, since JP '656 teaches substantially the same subject matter of the same structure/composition and for the same application (an adhesive sheet of the same adhesive polymers, such as styrene-butadiene-styrene copolymer, etc., for cleaning a screen printing plate by adhering and adsorbing the paint) as the instant invention, a suitable ink solvent absorption rate is reasonably considered to be either anticipated by JP '656, or an obvious routine optimization, motivated by the desire to adhere and adsorb the paint efficiently. Further, since the Declaration dated 8/18/2005 by Tsuyoshi Hiramatsu states that the 'solid' adhesive layer "does not mean to exclude layers including fine foam" [page 2], the self-adhesive layer of JP '656 reads on the instant invention as claimed. Finally, with respect to the new limitation in claim 2 that the adhesive layer is formed by a process using a forming technique excluding a foaming technique, since it appears to be new matter, as set forth above, hence has not been given any patentable weight for the present Office action.

For claims 22 and 27, JP '656 teaches that suitable adhesives include acrylic resin, such as a copolymer of acrylic acid and C<sub>2</sub>-C<sub>10</sub> alkyl ester and styrene, etc. [paragraph 0008].

For claims 23 and 28, JP '656 is silent about the amount of crosslinking agent in the adhesive layer. However, since JP '656 teaches that crosslinking agent may be contained in the adhesive layer 3 [paragraph 0009], a suitable amount of crosslinking agent is reasonably considered to be either anticipated by JP '656, or an obviously provided by practicing the invention of prior art.

For claims 24 and 25, JP '656 teaches that various additives such as plasticizer, antioxidant, etc., may be contained in the foamed adhesive layer [paragraph 0009].

For claim 26, JP '656 teaches that the tackiness of the adhesive layer is 1-200 gf/25-mm, measured by the test method JIS-Z-0237, and can be adjusted by choosing suitably a class of resin, a class of additive, an amount, etc. Since JP '656 uses the same test method as instantly claimed method, the examiner takes Official notice that the unit "cN/25-mm" is equivalent to the expression of "gf/25-mm".

### *Response to Argument*

6. In the remarks filed 8/8/2009, page 10, applicants point amended claim 2 and argue that claim 2 does not include a foaming process. However, since an express or inherent support is lacking, the new limitation has not been given any patentable weight in the present Office action, as set forth above.

Applicants argue at pages 10-11 that the present invention is patentably and structurally distinct from the JP '656 foamed embodiment, because while the recited "solid" adhesive layer can include "fine foam", it is not the same as the holes generated by the expansion step of JP '656. However, applicants are reminded that JP '656 teaches that the expansion ratio varies widely between 1.2 to 100 times, i.e., ranges from substantially solid to highly expanded foam, and applicants fail to provide any evidence that the "fine foam" of instant invention excludes the substantially solid foam of JP '656.

Applicants argue at page 12 that the examiner has not addressed pending claim 5. However, claim 5 has been previously cancelled.

Applicants argue at page 13 that the Declaration shows that that the efficiency of removal of a solvent-containing substance of the present invention is superior, because the instantly

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claimed adhesive sheet still has tackiness even after absorbing a predetermined amount of the solvent. However, since the same test method JIS-Z-0237 shows that the adhesiveness of JP '656 reads on the instantly claimed range, applicants' argument is unpersuasive.

Applicants argue at page 14 that a movie demonstration shows advantageous absorption and tackiness properties of the present invention, and has established unexpected results. However, JP 656 teaches that the tackiness of the adhesive layer is can be adjusted by choosing suitably a class of resin, a class of additive, an amount, etc., and is apparently not limited by the comparative examples in the Declaration, the Declaration fail to show unexpected results, and merely appears to be a desired improvement with certain embodiment. In particular, there is nothing in the Declaration to exclude the structural and/or composition of JP '656.

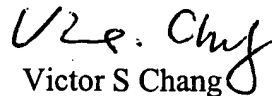
### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Victor S Chang  
Examiner  
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10/11/06